

REMARKS

By way of this amendment, claim 1, the only independent claim, has been amended to recite that the visual stream is dynamic both with respect to pattern and color with changes therein being at the frequency of the sound, namely between 3 and 30 Hz, and being in concert with the sound. Support for these amendments is found in original claim 5 as filed as well as in the specification at page 3, line 22 – page 4, line 3. As such, it is submitted that no new matter has been added to the application by way of this amendment.

Currently, claims 1, 4 and 6 remain rejected under 35 U.S.C. §103(a) over Yoshida et al. (US 5,982,414) in view of www.stanford.edu/~dement/sleeplinks.html and Meier et al. (US 5,496,962 A).

Standards for Obviousness Rejection and Response

The Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007), has recently articulated the standard for establishing whether a claim is obvious over prior art. In *KSR* the Court reestablished that the analysis of *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), remains the controlling precedent. Under *Graham*, to establish a *prima facie* case of obviousness an Examiner must analyze:

- (1) the scope and content of the prior art;
- (2) the differences between the claimed invention and the prior art; and
- (3) the level of ordinary skill in the pertinent art.

Graham, 383 U.S. at 17–18, 148 USPQ at 467.

It is Applicant's understanding that the form and substance of rejections under 35 U.S.C. §103(a) are currently governed by guidelines articulated in the Federal Register, 2007, Vol. 72, No. 195, 56525-56534 therein embodying the test outlined in *KSR*. These guidelines require a

factual inquiry, resolution of ordinary skill in the art to which the invention pertains, and an explicit recitation of the rationale for the rejection as selected from among seven possible bases (identified in the Federal Register with letters A-G). The basis for Applicant's reply is also provided within the Federal Register guidelines.

While the outstanding rejection appears to address the scope and content of the prior art and the differences between the claimed invention and the prior art, the level of ordinary skill in the art is not articulated either expressly or inherently. As such, the outstanding rejection fails to satisfy all elements required for a finding of obviousness as required under the analysis defined in *Graham* and reaffirmed in *KSR*. Applicant's remarks *infra* address each of the *Graham* elements and the rationale for a conclusion of obviousness.

Graham Factual Findings and Response Thereto

Yoshida serves as a primary reference and with respect to the visual stream is cited for teaching "that patterned changing of colors (e.g. color blue and the absence of blue) along with sound help to include sleep (Col. 5, lines 18-30; Col. 7, lines 35-Col. 8, lines 60)." (Paper No. 20080428, section 2, paragraph spanning pages 2-3). Also with respect to claim 1, Yoshida is cited as deficient in that "Yoshida does not clearly disclose the web/internet link to information of sleep related research, sleep products and a sleep discussion chat room and a visual stream incorporating patterns and changing colors in concert with the sound." (Paper No. 20080428, section 4, page 4).

To support inclusion of a web link to information of sleep related research, sleep products or a sleep discussion chat room, reference is made to the web link www.stanford.edu/~dement/sleeplinks.html as providing links to other sleep sites relating to research information, a chat room and product information with respect to sleep disorder issues.

The basis being that “it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Yoshida to have URL link ... for the benefit of providing users with additional information related to sleep disorder issues.” *Id.*

To support the proposition that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Yoshida to have the visual stream also incorporate patterns and change colors in concert with the sound,” *id.* at 4-5, Meier is cited as teaching that the “visual stream incorporates patterns and changes color in concert with the sound (See col. 17 lines 21-43).” *Id.* at 4.

Resolution of One of Ordinary Skill in the Art

Part of the *Graham* factual inquiry requires an indication of the level of ordinary skill in the art to which the invention pertains. Within the outstanding Office Action, as such, it is respectfully requested that the level of ordinary skill in the art be stated with greater specificity as the present invention requires skills beyond those imparted to a single person of ordinary skill in the art. Upon identification of the level of ordinary skill in the art, Applicant reserves the right to make of record additional declarations provided under 37 CFR 1.132 detailing how particular claimed aspects are beyond the scope of various such professional individuals such as a chemist or biochemist.

Rationale for Obviousness

The Supreme Court and the Court of Appeals for the Federal Circuit are in agreement that the teaching, suggestion, and motivation test as used by the CAFC is fully consistent with an analysis of obviousness under *Graham*. The Court in *KSR* articulated that “[t]here is no necessary inconsistency between the idea underlying the TSM test and the *Graham* analysis,” and explained that the CAFC has, in many cases, applied the TSM test in accord with the

principles of *Graham*. *KSR*, 127 S. Ct. at 1732, 82 USPQ2d at 1396. The Supreme Court also commented that the CAFC “no doubt has applied the test in accord with these principles [set forth in *KSR*] in many cases.” *Id.*

The standard set down in *KSR* is fully in line with historical precedent. As supported by the CAFC, there must be an express evidentiary showing of where the prior art provides motivation to combine all elements of the claims. It is a well established legal principle that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Additionally, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). This suggestion or motivation must be made explicit. A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). The cited prior art combination fails each of these requirements.

In support of the above precedents, the Court in *KSR* suggested seven possible rationales for a finding of obviousness. These are captured in the Federal Register, 2007, Vol. 72, No. 195, 56525-56534, which serves as the current basis used by the USPTO for a finding of obviousness. These rationales are reproduced below.

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

(Federal Register, Vol. 72, No. 195, 57529).

The rejection is based on two assertions. First that “it would have been obvious to one of ordinary skill at the time the invention was made to modify Yoshida to have URLs link [website of stanford.edu] to related Web sites for the benefit of providing users with additional information related to sleep disorder issues.” (Paper No. 20080428, page 4). This assertion appears to rely on the belief that one of ordinary skill in the art would recognize that someone desperately trying to fall asleep by resort to a sound generator would rather search the Internet for research, engage in shopping or discussion.

Second, the rejection is based on the assertion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Yoshida to have a visual stream also incorporate patterns and change colors in concert with the sound, as taught by Meier, in order to enhance the video signal thereby increasing the interaction between the user and the system in order to efficiently convey certain frequencies to the user (Yoshida column 5, lines 18-41). *Id.* 4-5.

The explanations articulated in Paper No. 20080428 lead Applicant to the assumption that the rationale for obviousness corresponds to rationale (G) of the *KSR* obviousness examination guidelines, namely that the Examiner has found some teaching, suggestion or motivation either in Yoshida, the Stanford website, or Meier to modify Yoshida or to combine reference teachings.

In the event that Applicant's assumption as to the rationale for the rejection is incorrect, it is respectfully requested that the undersigned attorney of record be contacted at the earliest possible convenience so that a response may be provided consistent with the implicit rationale for the finding of obviousness. The requirements for an obviousness rejection based on rationale G are reproduced below.

To reject a claim based on this rationale, Office personnel must resolve the Graham factual inquiries. Office personnel must then articulate the following:

- (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) a finding that there was reasonable expectation of success; and
- (3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

(Federal Register, Vol. 72, No. 195, 57529).

Substantive Distinctions between Prior Art Reference Combination and Claimed Invention

No identified teaching in the cited prior art combination is submitted to be recognized by one of ordinary skill in the art as a teaching suggestion or motivation or indeed, the knowledge generally available to one of skill in the art to modify Yoshida or the Stanford website or Meier.

Specifically, a subject attempting to sleep has a disincentive to be stimulated through web browsing by way of the claimed web link and as such one of ordinary skill in the art would appreciate that offering a subject that needs to be brought into a relaxed and ultimately sleepy state (see Yoshida column 5, lines 18-29) would benefit from the stimulative effects of online chat, shopping, or attempting self medical diagnosis based on sleep research. As such, it is submitted that one of ordinary skill in the art would in fact lack the required teaching, suggestion or motivation for the combination of Yoshida and www.stanford.edu/~dement/sleeplinks.html; and indeed, based on these cross purposes of these references would be disinclined to do so.

With respect to visual stream recitation of pending independent claim 1, while Yoshida teaches the binary visual effect of blue screen or blank display screen as being inductive of relaxed state when coupled with corresponding sounds, Applicant submits that one of ordinary skill in the art lacks a suggestion or motivation to include the dynamic patterns of light and color change. As such it would be appreciated by one of skill in the art to be stimulative and not sedative. As part of this previous amendment, representative research articles were provided that visual stimulation is produced by varying patterns as opposed to a sedative effect.

In Paper No. 20080428, with respect to these references, it was stated that: "Furthermore, the documents cited by the applicant do not give any information about the environment in which the patterns of light and color change are applied (e.g. what is the frequency in which the patterns of light and color change are applied to the subject)." (Paper No. 20080428, page 3).

Applicant submits that rebuttal evidence after an obviousness rejection has been leveled is entitled to consideration. As the court stated in *In re Sullivan* 498 F3d 1345, 84 USPQ2d 1034, 1038 (Fed. Cir. 2007), when a patent applicant puts forth rebuttal evidence, the Board must

consider that evidence (citing *In re Soni*, 54 F.3d 746; *In re Sernaker*, 702 F.2d 989 (Fed. Cir. 1983)).

The references previously cited in the amendment of February 11, 2008 were not submitted as to the veracity of the teachings therein but rather the impact such knowledge would have on one of ordinary skill in the art attempting to combine references according to the outstanding rejection. As the literature is consistent with individual experience in that visual complexity associated with a visual stream dynamically changing patterns and colors stimulates a subject would disincline one of ordinary skill in the art to make the prior art reference combination necessary to maintain the outstanding obviousness rejection.

On the basis of the above remarks, reconsideration and withdrawal of the rejection as to claim 1 and the claims that depend therefrom, namely claims 4 and 6, under 35 U.S.C. §103(a) over Yoshida in view of www.stanford.edu/~dement/sleeplinks.html and further in view of Meier is requested.

Summary

Claims 1, 4 and 6 remain pending in this application. These claims are submitted to be in allowable form and directed to patentable subject matter. Reconsideration and withdrawal of the rejection as to these claims and the passing of this application to allowance are requested. Should the Examiner have any suggestions as to how to improve the form of any of the pending claims, he is respectfully requested to contact the undersigned attorney responsible for this application.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 07-1180.

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Respectfully submitted,

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